## REMARKS

This response is directed to the pending Advisory Action, in which the Examiner stated that applicant's response of September 25, 2007, did not put the application in condition for allowance because "it would appear that the process recited in claim 46 of the original application would have formed crystalline turbostratic boron nitride having the X-ray diffraction pattern exhibited in Fig. 7." Applicant respectfully submits that the Examiner's comment raises issues not previously raised in the prosecution of this reissue application. Furthermore, for the reasons set forth below, the Examiner should withdraw the rejections of record and allow this application.

As explained in applicant's previous response, MPEP 1412.02 requires the Examiner to answer three questions in making a rejection based on recapture:

(1) Was there broadening of the reissue claims as compared with the patent claims?

(2) Does any broadening aspect of the reissue claim relate to the surrendered subject matter?

(3) Were the reissue claims materially narrowed in other respects to compensate for the broadening in the area of surrender, and thus avoid the recapture rule?

The Examiner's argument in the Advisory Action does not appear to relate to any of these points and, applicant respectfully submits, was not raised previously in a way that would have permitted applicant to respond directly to the point the Examiner now makes.

Applicant is aware of the discussion in the paragraph bridging pages 2 and 3 of the Action to the effect that "the omission of the limitation that the product was made by any one of the methods of claims 43-48 is impermissible recapture," but that is the only mention of any of claims 43-48 in the pending Action as it relates to the question of recapture. The first Action on this application says even less about recapture. The Examiner has never raised the point regarding claim 46 now presented in the Advisory Action as a basis for rejection and, as a result,

should permit applicant a chance to respond to a properly framed rejection, should the Examiner decide not to allow this application.

Applicant also respectfully submits that the Examiner's comment in the Advisory Action is incorrect and that this application should accordingly be allowed. Application claim 43 issued as patent claim 1 with only a very minor formal amendment in the response filed October 10, 2000. Claim 46 as presented in the original prosecution read as follows:

> 46. A method for producing a crystalline turbostratic boron nitride, comprising:
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> providing a starting mixture comprising a boron source material and a nitrogen source material,
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> heating the starting mixture and thermally reacting the starting mixture to form a reaction product comprising a substantially amorphous boron nitride in an atmosphere of one atmospheric pressure or higher, said atmosphere of one atmospheric pressure or higher comprising an atmosphere within a vessel of a closed or quasi-closed state,
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> heating the reaction product at 1500°C or below in a non-oxidizing atmosphere, said non-oxidizing atmosphere comprising a nitrogen atmosphere, for a time period to produce a heated product and
>
> crystallizing the heated product to said crystalline turbostratic boron nitride.

Claim 68 was directed to a crystalline turbostratic boron nitride product "produced by any one of the methods of claims 43-48."

First, the remarks in the amendment of April 3, 2000, which added claims 43, 46 and 68 to the application, did not say anything that can even remotely be construed as indicating that "the process recited in claim 46 of the original application would have formed crystalline turbostratic boron nitride having the X-ray diffraction pattern exhibited in Fig. 7" as alleged by the Examiner. In the amendment filed October 10, 2000, there was likewise no statement that would support the Examiner's position. Claims 46 and 68 were canceled in the amendment dated May 25, 2001, without relevant comment, allowing claim 43 to issue as patent claim 1.

There is thus no basis in any statement by the Examiner or arguments made by applicant in the original prosecution to support the Examiner's assertion that claim 46 (or even claim 43) was directed to a product having the X-ray diffraction pattern depicted in FIG. 7.

The same result flows from a consideration of the disclosure of the patent itself. Claim 43 (patent claim 1) specifies that the starting material includes "an alkali-borate fluxing agent." Examples 6 and 7, which correspond to Fig. 7, employ a starting material that explicitly does not use borax, as stated at col. 18, line 64, so claim 43 could not have corresponded to Fig. 7 as alleged by the Examiner.

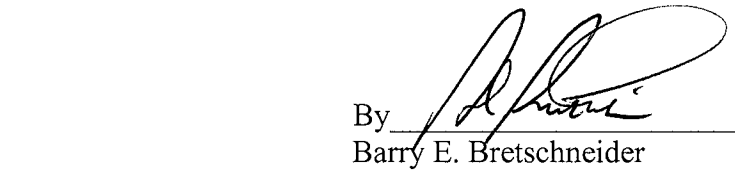
Claim 46 likewise does not correspond to FIG. 7 as alleged. Claim 46 corresponds instead to Examples 1 and 2, set forth at col. 16, line 64, to col. 18, line 9. Example 2 states unequivocally at col. 17, lines 51-52, that the X-ray diffraction pattern of the product of Example 1 is shown in FIG. 2, and not in FIG. 7. FIG. 7 depicts the X-ray diffraction pattern of the product produced in Examples 6 and 7, set forth at col. 18, line 63, to col. 19, line 37. As applicant clearly explained in his most recent reissue declaration, the error he seeks to have corrected by this reissue application is the failure to claim the subject matter of Examples 6 and 7, depicted in FIG. 7. Since the independent method claims from which canceled claim 68 depended, claim s43 and 46, did not claim any product as depicted in Fig. 7, the cancellation of claim 68 could not have surrendered (or have intended to surrender) coverage over the product depicted in Fig. 7. Only claim cancellations that deliberately surrendered claim coverage trigger the recapture rule. *Medtronic, Inc. v. Guidant Corp.*, 465 F.3d 1360, 1374-76 (Fed. Cir. 2006). As a result, the Examiner has provided no factual basis for the assertion on which he now relies to reject the added claims in this application.

For the foregoing reasons, early action allowing claims 1-16 is solicited. If this response contains any formal error that may be overcome by amendment, the Examiner is respectfully requested to telephone the undersigned to discuss such amendments.

In the event that the transmittal form is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief (such as payment of a fee under 37 CFR 1.17 (p)) is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petition and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing 251002008830.

Dated: November 16, 2007

Respectfully submitted,



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